

REMARKS

Prior to the mailing of the Office Action on March 23, 2005, claims 1-34 were pending. The above Amendment to the claims cancels no claims, and amends claims 1, 22, 25, 30, and 34. Claims 17-21, 28, and 29 have been withdrawn. Therefore, claims 1-16, 22-27, and 30-34 are currently pending.

Election of Group I Claims

On page 2 of the Office Action the Examiner indicated an Election between the claims of Group I and Group II was required. Applicants have elected to pursue the claims of Group I including claims 1-16, 22-27, and 30-34. Please withdraw the claims of Group II from further consideration including claims 17-21, 28, and 29.

Amendments to the Drawings

On page 3 of the Office Action the Examiner indicated the Drawings were objected to because they include Element A (Figure 7), which is not disclosed in the specification. Applicants direct the Examiner to Page 12, Line 27 of the Specification in which arrow A is disclosed, and indicates the direction in which a user may manually rotate the actuator 16.

The Examiner also objected to the Drawings for failing to illustrate element 17, a body. FIGS. 7 and 8 have been amended to illustrate element 17. A replacement drawing sheet containing FIGS. 7 and 8 is provided in Attachment A.

Amendments to the Specification

On page 4 of the Office Action the Examiner objected to the Specification because of an informality in which "a means for biasing a bolt 18" included the incorrect reference numeral. An amended paragraph has been submitted herewith in which this informality has been corrected by replacing 18 with 14.

Claim Objections

At page 4 of the Office Action, claims 1, 22, 25, 30, and 34 have been objected to because the claims included "A widow" rather than "A window." Each of these claims has been amended to correct this informality.

35 U.S.C. § 102 (b) Rejection of Claims 1-4, 13-16, 22, and 23

At page 4 of the Office Action the Examiner rejects claims 1-4, 13-16, 22, and 23 under 35 U.S.C. § 102 (b) as being anticipated by U.S. Patent No. 5,806,900 to Bratcher et al ("Bratcher").

The Examiner contends that Bratcher discloses a window stop (10) that comprises a housing (12); a bolt (14) mounted inside the housing; biasing means (16 and 18); a cover (32) defining a lip; and a resilient tab or extension member (34). The bolt is moveable between an extended and a retracted position (Figures 7 and 8).

The Applicants traverse this rejection as to each of claims 1-4, 13-16, 22, and 23.

The factual determination of anticipation requires the disclosure in a single reference of every element of the claimed invention. *Ex Parte Levy*, 1990 Pat. App. LEXIS 18, *3, 17 U.S.P.Q. 2d 1461 (BPAI 1990) (it is incumbent upon the examiner to identify wherein each and every facet of the claimed invention is disclosed in the applied reference.); *In re Lange*, 209 U.S.P.Q. 288 (CCPA 1981) (in order to anticipate, the reference must describe or disclose all of the limitations of the claims). It is well-settled law that the burden of establishing a *prima facie* case of anticipation resides with the Patent & Trademark Office. *Ex Parte Skinner*, 1986 Pat. App. LEXIS 4, 2 U.S.P.Q. 2d 1788 (BPAI 1986).

Claim 1 of the present Application includes, among other things, "mount structure capable of being mounted to a wall having a thickness between a range of thicknesses from a minimum thickness to a maximum thickness." As shown in FIGS. 3 and 15, and as described in the Specification at Page 18 Line 4, the mount structure of the housing is adapted to receive any wall having a thickness between a minimum thickness and a maximum thickness. Various embodiments of mount structure according to the elements of claim 1 are shown throughout the Specification.

Bratcher fails to disclose this element of claim 1. In Bratcher, no structure is provided for mounting the window stop to walls of differing thicknesses. The stop disclosed in Bratcher mounts into a single wall having a set thickness. Applicants have depicted the problem associated with prior art window stops such as Bratcher in FIG. 11 of the present application. Where the wall is too thick, the prior art window stop cannot be securely mounted to the window because the tabs will not expand and secure to the wall. It can also be appreciated that where the wall is too thin the window stop cannot be securely anchored, and instead will have room to shift during use.

Because this element of claim 1 is not shown or suggested anywhere within Bratcher, Applicants submit claim 1 is in a condition for allowance.

Claims 2-4 and 13-16 each depend, directly or indirectly, from claim 1, and include all limitations thereof. Therefore, each of claims 2-4 and 13-16 is also patentably distinct from Bratcher.

Claim 22 of the Application includes, among other things, "means for mounting the housing to a wall having a thickness chosen from any of a plurality of thicknesses." As discussed above with respect to claim 1, Bratcher does not disclose a mount structure capable of being mounted to walls of differing thicknesses. Likewise, Bratcher also does not disclose or suggest means for mounting to walls having differing thicknesses. For this reason, Applicants submit claim 22 is patentable over Bratcher.

Claim 23 of the Application includes, among other things, "wherein the engagement surface and lip are adapted to cooperatively engage the frame member, the frame member being any of a plurality of frame members having a thickness between a minimum thickness and a maximum thickness." As discussed above with respect to claims 1 and 22, Bratcher does not disclose or suggest any means for mounting to walls of differing thickness. More particularly, Bratcher does not disclose or suggest an engagement surface and lip which are so adapted as present in claim 23. For this reason, Applicants submit claim 23 is patentable over Bratcher.

Rejection of Claims 5-12, 24-27, and 30-34 Under 35 U.S.C. § 103 (a)

At page 5 of the Office Action the Examiner rejects claims 5-12, 24-27, and 30-34 under 35 U.S.C. § 103 (a) as being unpatentable over Bratcher in view of U.S. Patent No. 6,250,694 to Weiland (Weiland).

Applicants submit that the Examiner has not presented a *prima facie* case of obviousness. As such, the rejection is improper. It is the burden of the Patent and Trademark Office to establish a *prima facie* case of obviousness when rejecting claims under 35 U.S.C. §103. *In re Reuter*, 210 U.S.P.Q.2d 249 (CCPA 1981). To establish a *prima facie* case of obviousness, three basic criteria must be met: first, there must be some suggestion, incentive or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings; second, there must be a reasonable expectation of success; and third, the prior art references must teach or suggest all the claim limitations. *In re Geiger*, 815 F.2d 686, 688 (Fed. Cir. 1988). Furthermore, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in the Applicants' disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

The cited references individually do not teach Applicants' invention, and there is no motivation to combine these references. For such a rejection to be proper there must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the modification suggested by the Examiner. That knowledge cannot come from the Applicants' invention itself. *In re Oetiker*, 977 F.2d 1443, 1447 (Fed. Cir. 1992). Further, "the mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." *In re Fritch*, 972 F.2d 1260, 1266 (Fed. Cir. 1992). Thus, modification of Bratcher in view of Weiland in a manner that merely reconstructs Applicants' invention is improper and constitutes hindsight reconstruction. It is insufficient to present a *prima facie* case of obviousness.

It is improper to combine the Bratcher and Weiland references in the manner suggested. On page 5 of the Office Action, the Examiner stated that the Bratcher reference fails to disclose that the surface of the resilient tab or extension member (34) is inclined with respect to the lip and that the engagement surface comprises at least one ridge or protrusion. The Examiner

attempts to then apply Weiland as showing a resilient tab (44) that includes an engagement surface (46) to remedy the deficiencies of Bratcher.

However, no motivation or suggestion to combine the Bratcher and Weiland references has been cited by the Examiner. It is impermissible to use the claimed invention as an instruction manual or “template” to piece together the teachings of the prior art so that the claimed invention is rendered obvious. *In re Fritch*, 972 F.2d 1260, 23 USPQ 2d 1780, 1784 (Fed. Cir. 1992). One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention. *Id.* Therefore, the combination of Bratcher and Weiland is improper.

Furthermore, Weiland teaches away from Bratcher because Weiland utilizes a different bolt structure.

Applicant’s submit that because the references have been improperly combined, each of claims 5-12, 24-27, and 30-34 is in a condition for allowance.

Even if such motivation or suggestion to combine the references did exist, amended claim 24 includes an additional element not taught by either Bratcher or Weiland. In amended claim 24, at least one of the ridges is inclined away from the lip. This added element is shown in the third ridge 82 of FIG. 7 of the Application. Amended claim 24 is patentable for this additional reason.

Amended claim 30 also contains an additional element not taught by either Bratcher or Weiland. Amended claim 30 includes, among other things, “the tab having a planar engagement surface distal from the base portion, the planar engagement surface being spaced from the lip and inclined with respect to the lip.” An example of such a planar inclined engagement surface is shown in the present application as reference numeral 245 of FIG. 15. This element is not taught by either Bratcher or Weiland.

As shown throughout Bratcher at FIGS. 3-9, the clips 34 that extend from the housing 12 do not meet the requirement of claim 30. The clips 34 of Bratcher do not have a planar engagement surface that is inclined with respect to the lip. This is significant because it allows the housing of the Applicants’ claim 30 to be mounted to walls of differing thicknesses.

This deficiency in Bratcher is not remedied by Weiland. In Weiland, as shown in FIGS. 1 and 2, the outer snap legs 44 all include ridges 46. Therefore, Weiland does not have a planar engagement surface that is inclined with respect to the lip as required by claim 30.

Claims 31-33 each depend from claim 30 and include all of the limitations thereof. Therefore, each of claims 31-33 is also patentably distinct from the suggested combination of Bratcher with Weiland.

Independent claim 34 includes, among other things, "each tab having a smooth engagement surface distal from its base portion, each smooth engagement surface being spaced from the lip and inclined with respect to the lip." An example of such a planar inclined engagement surface is again shown in the present application as reference numeral 245 of FIG. 15. This element is not taught by either Bratcher or Weiland. As discussed above with respect to claim 33, Bratcher and Weiland both fail to show a smooth, or planar, inclined engagement surface. Applicants submit claim 34 is patentably distinct from the proposed combination of Bratcher and Weiland.

Therefore, Applicants submit that each of the pending claims is in allowable form and respectfully requests notice of same.

Appl. No.: 10/752,406
Attorney Docket No.: 1247 P 290
Reply to Office Action of March 23, 2005


CONCLUSION

Applicants submit the application is in condition for allowance. Such allowance is respectfully requested. The Examiner is also requested to contact the undersigned if the Examiner has any questions concerning this Reply or if it will expedite the progress of this application.

Respectfully submitted,

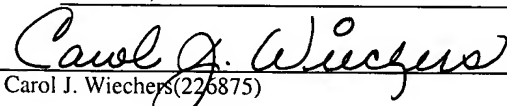
Dated: June 23, 2005

By: _____


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CERTIFICATE OF MAILING (37 C.F.R. § 1.8a)

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on June 23, 2005


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ATTACHMENT A

Replacement FIGS. 7 and 8 are provided on the attached Replacement Drawing Sheet.
The amended FIGS. 7 and 8 now clearly identify reference numeral 17.